

REMARKS**I. Summary**

Claims 1-36 are pending in the application. In the non-final Office Action mailed June 2, 2005, claim 36 was withdrawn from consideration by the Examiner as a non-elected claim. Claims 1-14, 17-31, and 33-35 were rejected. Claims 15, 16, and 32 were objected to but indicated as allowable if rewritten in independent form. Applicant thanks the Examiner for this indication. The issues in the Office Action are:

- Claims 1-35 (Group I) and claim 36 (Group II) are subject to a restriction requirement.
- The oath/declaration is objected to.
- The drawings are objected to.
- Claims 1-7, 9-14, 17-29, and 33-35 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Ewer et al.* (U.S. Patent No. 6,344,611, hereinafter *Ewer*).
- Claims 1-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Saeki et al.* (U.S. Patent No. 6,444,903, hereinafter *Saeki*) in view of *Hodge* (U.S. Patent No. 5,146,532).
- Claims 30 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ewer*.

Applicant respectfully traverses all outstanding objections and rejections and requests reconsideration in view of the arguments presented below.

II. Election/Restriction

Claims 1-35 (Group I) and claim 36 (Group II) are subject to a restriction requirement. Applicant affirms the provisional election, with traverse, to continue prosecution of the Group I claims (1-35) made during a telephone conference on May 26,

2005 with the Examiner. Applicant's traversal of the restriction requirement is supported by the arguments below.

The Examiner states that Group II and Group I are related as combination and subcombination. Two inventions are distinct if 1) a combination as claimed (here, Group II) does not require the particulars of the subcombination as claimed (here, Group I) for patentability and 2) the subcombination can be shown to have utility either by itself or in other and different relationships. *See* M.P.E.P. § 806.05(c). The Examiner states that the combination (Group II) "does not require the particulars of the subcombination as claimed because the first and second channels having a cover and a gasket positioned between said channels and said electronic enclosure are not required." Applicant respectfully asserts that the Examiner's statement fails to demonstrate that the combination of Group II does not require the particulars of Group I for patentability. The Examiner has demonstrated only that the Group II combination comprises limitations not recited by the Group I subcombination. Thus, the Examiner has not demonstrated that the combination as claimed does not require the particulars of the subcombination for patentability, as required by M.P.E.P. § 806.05(c) for a showing of distinctness.

Additionally, to support a requirement for restriction "both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search." *See* M.P.E.P. § 806.05(c) (emphasis added). The Examiner has stated only that "the search required for Group I is not required for Group II." Applicant respectfully asserts that because the claims of Group I are similar to those of Group II, a search for Group I necessarily includes a search for Group II. Accordingly, the Examiner has not made the required showing of M.P.E.P. § 806.05(c), and the restriction requirement is not proper. For the reasons presented above, Applicant respectfully requests that the restriction requirement for Groups II and I be withdrawn.

III. Objection to the Oath/Declaration

The oath/declaration is objected to by the Examiner. Applicant respectfully points out that signed declaration forms in compliance with 37 C.F.R. §§ 1.63 & 1.68 were submitted by each of the inventors on April 26, 2004. Neither 37 C.F.R. § 1.63 nor § 1.68 prohibit the submission of separately signed inventor declarations in satisfaction of the oath/declaration

requirements. The M.P.E.P. also indicates that separately signed declarations by joint inventors may be submitted. *See* M.P.E.P. § 602 (IV) (“When joint inventors execute separate oaths or declarations...”). Applicant respectfully requests that the Examiner withdraw the objection to the submitted declarations in view of the above.

IV. Objections to the Drawings

The drawings are objected to under 37 C.F.R. § 1.83(a). The Examiner states that the drawings must show every feature of the invention specified in the claims, and further states that the “gasket” must be shown or the feature canceled from the claims.

Applicant respectfully requests the Examiner to reconsider the objection. M.P.E.P. § 608.02(f) provides that the requirement that all modifications described must be illustrated “does not apply to a mere reference to minor variations.” Applicant respectfully asserts that a gasket as recited by, for example, claim 15, is a minor variation adequately described in paragraph [0026] of the specification. Additionally, M.P.E.P. § 608.02(f) provides that modifications may not be shown in broken lines on figures which show in solid lines another form of the invention. Applicant respectfully notes that, in order to redress the Examiner's objection and comply with § 608.02(f), a drawing showing a gasket would require an entire additional figure. Accordingly, Applicant requests that the Examiner reconsider the drawing objection in view of the provisions of M.P.E.P. § 608.02(f).

V. Claim Rejections under 35 U.S.C. § 102(b)

Claims 1-7, 9-14, 17-29, and 33-35 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Ewer*. To anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim, see M.P.E.P. § 2131.

Claim 1 recites “a plurality of teeth spaced apart from one another and disposed in one of said first channel and said second channel...” *Ewer* teaches a wire delivery system comprising first and second dividing walls [26] that extend from bottom wall [20] forming three channels (two outer channels [20] and a middle channel [22]). *See Ewer* at col. 3, lines 43-47. *Ewer* does not teach a plurality of teeth disposed in channels [20] or [22]. Accordingly, *Ewer* does not teach at least the above-recited limitation of claim 1. Thus, *Ewer* does not anticipate claim 1.

Claim 19 recites a method comprising “disposing a plurality of teeth in one of said first channel and said second channel....” *Ewer* teaches a wire delivery system comprising first and second dividing walls [26] that extend from bottom wall [20] forming three channels (two outer channels [20] and a middle channel [22]). *See Ewer* at col. 3, lines 43-47. *Ewer* does not teach a plurality of teeth disposed in channels [20] or [22]. Accordingly, *Ewer* does not teach at least the above-recited limitation of claim 19. Thus, *Ewer* does not anticipate claim 19.

Claim 24 recites “a second channel having a base, a plurality of sides, and a plurality of teeth spaced apart from one another operating to create spaces....” *Ewer* teaches a wire delivery system comprising first and second dividing walls [26] that extend from bottom wall [20] forming three channels (two outer channels [20] and a middle channel [22]). *See Ewer* at col. 3, lines 43-47. *Ewer* does not teach a plurality of teeth disposed in channels [20] or [22]. Accordingly, *Ewer* does not teach at least the above-recited limitation of claim 24. Thus, *Ewer* does not anticipate claim 24.

Claim 33 recites a mechanism comprising “means for increasing a bend radius of said plurality of cables while transitioning from said first direction routing means to said second direction routing means.” *Ewer* teaches a base fitting [14] that provides a specific bend radius. However, *Ewer* does not appear to teach a means for increasing a bend radius of a plurality of cables. Accordingly, *Ewer* does not teach at least the above-recited limitation of claim 33. Thus, *Ewer* does not anticipate claim 33.

Each of claims 2-7, 9-14, 17-18, 20-23, 25-29, and 34-35 depends directly or indirectly from claim 1, 19, 24, or 33. As such, each of claims 2-7, 9-14, 17-18, 20-23, 25-29, and 34-35 comprises all limitations of the base claim from which it depends. As shown above, *Ewer* does not teach all limitations of claims 1, 19, 24, and 33. Accordingly, *Ewer* does not teach all limitations of claims 2-7, 9-14, 17-18, 20-23, 25-29, and 34-35. Thus, these claims are not anticipated by the cited reference. For the reasons above, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 102(b) rejection of record and pass these claims to issue.

VI. Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Saeki* in view of *Hodge*.

Claims 30 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ewer*.

To establish a prima facie case of obviousness, three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the second criteria, Applicant respectfully asserts that the references do not meet the third criteria. Furthermore, Applicant respectfully asserts that the Examiner has not provided proper motivation for combining *Saeki* and *Hodge*.

References Do Not Teach All Limitations

Claims 1-8

Claims 1-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Saeki* in view of *Hodge*. Claim 1 recites “a plurality of teeth spaced apart from one another and disposed in one of said first channel and said second channel...” The Examiner admits that *Saeki* does not teach or suggest at least this limitation of claim 1. *See* Office Action, page 12. The Examiner states that *Hodge* “teaches a plurality of teeth (58) being positioned on a mounting surface (see figure 1)...” Applicant respectfully disagrees. The assembly (58) of *Hodge* comprises a base member [10] which “includes a plurality of U-shaped channels [14].” *See Hodge* at col. 3, lines 10-13. *Hodge* does not teach or suggest a plurality of teeth spaced apart from one another and disposed in one of a first channel and a second channel. Accordingly, *Hodge* does not teach or suggest at least the above-recited limitation of claim 1. Thus, *Saeki* in view of *Hodge* does not teach or suggest all limitations of claim 1, and claim 1 is not obvious over the cited references.

Each of claims 2-8 depends directly or indirectly from claim 1. As such, each of claims 2-8 comprises all limitations of base claim 1 from which it depends. As shown above, *Saeki* in view of *Hodge* does not teach all limitations of claim 1. Accordingly, *Saeki* in view of *Hodge* does not teach or suggest all limitations of claims 2-8. Thus, these claims are not obvious over the cited references.

Claims 30 and 31

Claims 30 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ewer*. Each of claims 30 and 31 depends directly from claim 24. As such, each of claims 30 and 31 comprise all limitations of base claim 24. As shown above under heading “Claim Rejections under 35 U.S.C. § 102(b),” *Ewer* does not teach or suggest all limitations of claim 24. Accordingly, *Ewer* does not teach or suggest all limitations of claims 30 and 31. Thus, claims 30 and 31 are not obvious over *Ewer* under 35 U.S.C. § 103(a).

No Motivation for Combining *Saeki* and *Hodge*

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. The Examiner states that one of ordinary skill in the art would have combined the teachings of *Saeki* with the teachings of *Hodge* “to positively locate and retain one or more cables while providing strain relief.” *See* Office Action, page 12. Applicant respectfully traverses this assertion. *Saeki* already teaches a hinge structure that prevents electric wires from receiving excessive bending stress at the hinge portion. *See Saeki* at col. 2, lines 28-53. Accordingly, one of ordinary skill in the art would not be motivated to combine the teaching of *Hodge* to provide strain relief. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

For the reasons above, Applicant respectfully requests that the Examiner withdraw the rejection of record under 35 U.S.C. § 103(a) and pass these claims to issue.

VII. Conclusion

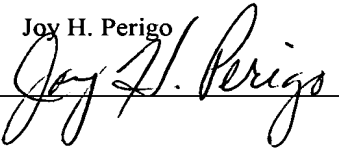
In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 200312987-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV482711840US in an envelope addressed to: M/S Amendment, Commissioner for Patents, P O Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: September 2, 2005

Typed Name: Joy H. Perigo

Signature: 

Respectfully submitted,

By: 

Michael A. Papalas
Attorney/Agent for Applicant(s)
Reg. No. 40,381
Date: September 2, 2005
Telephone No. (214) 855-8186